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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Elliott D. Light

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10/20/2006

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EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/559,778		LIGHT ET AL.	
	Examiner		Art Unit	
	James H. Zurita		3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80-86,89-98,101-110 and 113-115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80-86,89-98,101-110 and 113-115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

On 27 April 2000, Applicant filed the present application as a continuation in part of 09/167873, filed 7 October 1998, now US patent 6,092,053, issued on 18 July 2000.

On 18 June 2003, the Examiner rejected claims 1-79 as unpatentable over Peckover, WO 97/26612-A1, international publication date of 24 July 1997, in view of Greene, "Online College Applications, Pushing Out Paper", 1 September 1997, St. Louis Post - Dispatch; St. Louis, Mo.

On 3 September 2003, Applicant cancelled claims 1-79, adding claims 80-115.

On 19 November 2003, in a Final rejection, the Examiner rejected claims 80-119 as unpatentable over Peckover (6,119,101) in view of *Walker* (5,794,207).

On 5 August 2004, Applicant filed a first Request for Continuing Examination (RCE). The accompanying amendment, while non-compliant, appeared to be a bona-fide attempt to respond. The Examiner provided applicant with a one-month period to respond. Applicant's response of 20 August 2004 included a listing of all claims.

On 20 November 2004, the Examiner rejected claims 80-115 as unpatentable over Peckover in view of Walker, above.

On 27 January 2005, applicant filed a second request for reconsideration (RCE)

On 12 April 2005, the Examiner rejected claims 80-115 as being unpatentable over Peckover in view of Walker, above.

On 21 July 2005, applicant cancelled claims 87-88, 99-100, 111-112, and amended claims 80, 92, 93, 96-98 and 101-105.

On 31 October 2005, the Examiner rejected claims 80-86, 89-98, 101-110, 113-115 as being unpatentable over Peckover (6,119,101) in view of *Walker* (5,794,207).

On 6 April 2006, Supervisor Fadok agreed to reopen prosecution. A summary of the interview between counsel and Mr. Fadok was mailed on 9 May 2006.

On 7 April 2006, applicant filed a request for reconsideration.

On 1 May 2006, applicant filed a Notice of Appeal. No Brief has been filed.

This Office Action responds to applicant's request for reconsideration.

Response to Amendment

In view of applicant's request for reconsideration of 7 April 2006, prosecution is reopened and the finality of the previous Office Action is vacated.

Claims 80-86, 89-98, 101-110, 113-115 are pending and will be examined.

Priority

As conceded by applicant on 6 April 2006, priority date of parent is not available to this application.

As noted, the pending claims are drawn to data subject [consumer], data recipient [merchant] and data controller and interactions among these parties. As a CIP, the instant application ***adds*** and ***claims*** additional disclosure ***not*** in the prior application. For example, data controller, data repository, authorized data recipient [merchant]. Applicant admits this, as on page 3, lines 1-3, for example:

- | | |
|---|---|
| 1 | system to provide this for merchants is disclosed in copending application Serial No. 09/167,873, filed |
| 2 | October 7, 1998, incorporated herein by reference in its entirety. The present invention expands upon |
| 3 | this system to data controllers and authorized data recipients. |

On page 11, line 14-page 12, line 21, applicant argues that the instant application is entitled to the parent application filing date. The instant application is a continuation-in-part (CIP) of application 09/167873, filed 7 October 1998, issued on 18 July 2000 as US Patent 6,092,053. See MPEP 201.08.

Information Disclosure Statement

The information disclosure statement filed 5 August 2004 refers to four non-patent literature documents that were filed in parent application 09/167873. The Examiner has made copies of these and made them of record in the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 83 and 85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims refer to "...***preferred*** shipping method..." but do not allow consumers to make a preference known.

For purposes of Examination, the term "...***preferred*** shipping method..." will be given its broadest reasonable interpretation to include all shipping methods that permit a consumer to receive their purchases.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 80, 81, 92, 93, 95, 104, 105 are rejected under 35 U.S.C. 102(e) as being anticipated Paltenghe (US PG-PUB 2001/0011250A1).

For purposes of Examination, Data subject is interpreted as a consumer/customer, data recipient is interpreted as a merchant. Data subject registration is interpreted as having a consumer's information retained on a data repository. Purchase query is interpreted as an offer to buy sent by a merchant to a consumer. Purchase reply is a consumer's acceptance of a merchant's offer.

As per claim 80, Paltenghe discloses method(s) for allowing

- a data subject (consumer, reference 25)
- to purchase (see, for example, at least paragraph 0061 and references to consumer purchases)

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- an item (see, for example, at least references to goods, paragraph 0029)
- from a data recipient [merchant] (merchants and service providers, reference 27)
- over a computer network (Internet, for example, paragraph 6, network, paragraph 0045), comprising:

(a) **receiving**, from a data subject network communication device (see at least paragraph 0010)

- an offer associated with a the data recipient [merchant] (see, for example, merchant offers, paragraph 0062; they are associated with merchants) and
- a message (see, for example, message(s), as in paragraph 0049, communication messages to/from consumers and Information Bank 23)
- including a network communication device software identifier (see, for example, at least paragraph 0007 and references to cookies), the
- offer and the message being received at a data repository computer (see, for example, specific merchant offers received at Information Bank, forwarded to specific consumers, the offer associated with a specific merchant being accepted by the specific consumer; then the acceptance of that offer sent to the Information Bank as message 29 from consumer 25 to Information Bank 23, as in Fig. 1);

(b) **determining** whether the data subject is registered (see, for example, references to service account, where consumer information may be stored for future use, as in applicant's disclosures, page 26, lines 26-27);

(c) **determining** whether the data recipient [merchant] is authorized (see, for example, at least references to authorized merchants, as in paragraph 0010);

(d) [if the data subject is registered and the data recipient [merchant] is authorized], **retrieving** purchasing information associated with the data subject from a database in the data repository computer (see, for example, at least paragraphs 0014 and 0071, concerning purchasing information such as credit card);

(e) sending a purchase query to the data subject network communication device (see, for example, at least paragraphs 0026, consumers can search shop and negotiate, and 0061, the information bank sends merchant's offer to a consumer) ; and

(f) in response to a purchase reply received from the data subject network communication device, sending purchase transaction information to the data recipient [merchant]. See, for example, at least paragraph 0029, concerning billing consumers for purchases.

As per claim 81, Paltenghe discloses that determining whether the data subject [consumer] is registered includes determining whether the network communication device software identifier matches an entry in the database (see, for example, at least references to cookies, as in paragraph 0007).

As per claim 83, Paltenghe discloses that purchasing information associated with the data subject [consumer] includes credit card information and shipping information, the shipping information including a shipping address and a preferred shipping method (see, for example, at least paragraphs 0071, 0072).

Claim 92 is rejected on the same grounds as claim 80.

Claim 93 is rejected on the same grounds as claim 81.

Claim 95 is rejected on the same grounds as claim 83.

Claim 104 is rejected on the same grounds as claim 80.

Claim 105 is rejected on the same grounds as claim 81.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 82-86, 89-91, 94, 96-98, 101-103, 106-110, 113-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe in view of Meyers (US 6,915,271).

As per claim 82 Palthenge ***does not*** specifically disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number. Meyer discloses that the offer includes a data recipient [merchant] identifier (see, for example, references to URL, as in Col. 39, lines 29-55), an item price (see, for example, at least Col. 41, line 66-Col. 42, line 25), a data recipient [merchant] digital signature (see at least Col. 47, line 48-Col. 48, line 4), a final price indicator and a transaction number (see, for example, at least Col. 41, line 66-Col. 42, line 25, total price, transaction ID number).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number for the obvious reason that the details may be used for tracking and analysis on a regular basis, possibly identifying suspicious patterns.

As per claim 84, Palthenge **does not** specifically disclose determining whether the credit card information is accepted by the data recipient [merchant]. Meyer discloses determining whether the credit card information is accepted by data recipient [merchant] (see, for example, at least Col. 41, lines 22-40, Col. 50, lines 38-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyers to disclose determining whether the credit card information is accepted by the data recipient [merchant].

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyers to disclose determining whether the credit card information is accepted by the data recipient [merchant] for the obvious reason that a merchant may wish to get paid for purchases.

As per claim 85, Paltenghe discloses obtaining a new price from the data recipient [merchant] based on the shipping address and the preferred shipping method; and setting the item price equal to the new price (see, for example, at least paragraph 0072).

As per claim 86, Palthenge **does not** specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database. Meyer discloses prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database (see, for example, at least Col. 33, lines 23-34, Col. 39, lines 29-35).

It would have been obvious to one of ordinary skill at the time the invention was made to combine Palthenge and Meyer to specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database.

One of ordinary skill at the time the invention was made would have been motivated to combine Palthenge and Meyer to specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database for the obvious reason that consumer information may thus be protected from unauthorized use.

As per claim 89, Palthenge **does not** specifically disclose storing the transaction information in an authorized data recipient [merchant] transaction log. Meyer discloses storing the transaction information in an authorized data recipient [merchant] transaction log (see, for example, at least Col. 50, lines 53-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose storing the transaction information in an authorized data recipient [merchant] transaction log.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose storing the transaction information in an authorized data recipient [merchant] transaction log for the obvious reason that merchants may wish to analyze the data periodically and on a regular basis, such as for suspicious patterns.

As per claim 90, Palthenge does not specifically disclose storing the transaction information in a data subject [consumer] transaction log. Meyer discloses storing the transaction information in a data subject [consumer] transaction log (see, for example, at least Col. 4, lines 8-31, Col. 8, lines 11-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose storing the transaction information in a data subject [consumer] transaction log.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose storing the transaction information in a data subject [consumer] transaction log for the obvious reason that merchants may wish to analyze the data periodically and on a regular basis, such as for suspicious patterns.

As per claim 91, Palthenge **does not** specifically disclose sending a transaction confirmation message to the data subject [consumer]. Meyer discloses sending a transaction confirmation message to the data subject [consumer] (see, for example, at least Col. 41, lines 22-40, Col. 42, line 59-Col. 43, line 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose sending a transaction confirmation message to the data subject [consumer].

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose sending a transaction confirmation message to the data subject [consumer] for the obvious reason of letting a consumer make purchases and to assure that settlement can take place.

Claim 94 is rejected on the same grounds as claim 82.

Claim 96 is rejected on the same grounds as claim 84.

Claim 97 is rejected on the same grounds as claim 85.

Claim 98 is rejected on the same grounds as claim 86.

Claim 101 is rejected on the same grounds as claim 89.

Claim 102 is rejected on the same grounds as claim 90.

Claim 103 is rejected on the same grounds as claim 91.

Claim 106 is rejected on the same grounds as claim 82.

Claim 107 is rejected on the same grounds as claim 83.

Claim 108 is rejected on the same grounds as claim 84.

Claim 109 is rejected on the same grounds as claim 85.

Claim 110 is rejected on the same grounds as claim 86.

Claim 113 is rejected on the same grounds as claim 89.

Claim 114 is rejected on the same grounds as claim 90.

Claim 115 is rejected on the same grounds as claim 91.

Response to Arguments

Applicant's arguments filed 7 April 2006 have been fully considered.

Prosecution is reopened and the finality of the previous Office Action is vacated.

On page 11, line 14-page 12, line 21, applicant argues concerning priority. See Priority, above.

On page 12, line 22-page 13, line 10, applicant traverses the provisional Double Patenting Rejection over application 09/572795, filed 17 May 2000, also a CIP of application 09/167873. Further evaluation indicates that the instant application should not require a terminal disclaimer at this time, and the rejection is withdrawn.

On page 13, lines 11-page 14, line 6, applicant traverses the rejection under 35 USC 112, second paragraph. The rejection is withdrawn in view of applicant's remarks that an "offer" would be clear to one of ordinary skill in the art. The Examiner notes that applicant's specification defines "offer" as a transaction (page 5, line 9) and that a "transaction may be the simple transmission of selected data subject information or for a purchase and sale of goods or services" (page 4, lines 5-6).

On page 14, line 7- page 16, line 22, Applicant's comments are moot in view of new grounds for rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
29 September 2006

James Zurita
Primary Examiner